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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By: /James A Henricks/
James A. Henricks, 31,168

Applicant: **Marc Radow**

Serial No.: 10/807,947

Filed: March 24, 2004

Title: RIMMING COMPOSITION

Examiner: **WEINSTEIN, Steven L.**

Group Art Unit: 1761

Confirmation No. 4071

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**SECOND RESPONSE TO NOTICE REGARDING
NON-COMPLIANT RESPONSE DATED MARCH 27, 2008**

Sir:

This responds to the marked items in the Notice Regarding Non-Compliant Response dated March 27, 2008. This response is being filed within one month after the date of the Notice, which relates to a non-final amendment. This response is being filed concurrently with a First Response to Notice Regarding Non-Compliant Response, which First Response addresses the Election of Species Requirement. In this Second Response, the numerous unanswered phone calls made in this case by the undersigned to the Patent Office are noted, and the marked items in the Notice Regarding Non-Compliant Response are addressed.

Applicant respectfully traverses the arguments that the Amendment Document was non-compliant, for the reasons indicated below under the Remarks heading. Because no changes are made to the amendments made in the December 28, 2007 Amendment Document, the same amendments as were presented before are not presented here again.

Application No.: 10/807,947
Second Response dated: April 28, 2008
Second Reply to Non-Compliant Notice: November 27, 2007
Atty. Ref.: 501120-015

It is noted here that no claims are withdrawn. When an election requirement is traversed, the non-elected claims are withdrawn only after the Examiner holds that they are directed to non-elected subject matter. This matter is addressed further below.

Amendments to the Specification -- None.

Amendments to the Claims -- None.

Amendments to the Drawings -- None.

Remarks/Arguments begin on page 3 of this paper.

Appendix -- None.

REMARKS

This responds to the March 27, 2008 Notice of Non-Compliant Amendment Document. The Notice addresses the Response filed by the undersigned attorney on behalf of the Applicant December 28, 2007. Because the undersigned attorney filed the Amendment Document at issue here, the Office is free to discuss the Amendment Document with the undersigned attorney, as discussed more fully below.

Record of Phone Calls Made To Examiner, SPE and SPRE – No Response From The Office

On or about April 20, 2008, the undersigned called Examiner Weinstein and left a voicemail asking the Examiner to return the call. The voicemail discussed in detail why it was believed that the Amendment Document was complete and complied with the Rules and MPEP. The voicemail also asked what else could be done to comply with the Rules and the MPEP. No return call was received from the Examiner or anybody else from the Office.

On April 23, 2008, the undersigned called Examiner Cano, the SPE for this case and left a voicemail asking Examiner Cano to return the call. The voicemail explained that the call was being made because Examiner Weinstein had not returned the earlier call. The voicemail also discussed in detail that the undersigned had filed the subject Amendment Document, and why it was believed that the Amendment Document was complete and complied with the Rules and MPEP. The voicemail also asked what remained to be done to comply with the Rules and the MPEP. The voicemail also indicated that if Examiner Cano would not call back the undersigned (even though the undersigned filed the subject Amendment Document), Examiner Cano was requested to call the Applicant. The undersigned, and upon information and belief the Applicant, received no return call from Examiner Cano.

On April 25, 2008, the undersigned called Tom Dunn, indicated in the Office Directory as being a Special Program Examiner (SPRE) for TC 1700. The undersigned left a voicemail with Mr. Dunn with the relevant facts, but never received a return phone call.

The Undersigned Attorney is Authorized to Act on Behalf of Applicant

The undersigned is authorized to act on behalf of Applicant both as to the Amendment Document and also as to the Notice of Non-Compliant Amendment Document. Specifically, the MPEP states that:

“Papers may be filed in patent applications and reexamination proceedings by registered attorneys or agents not of record under 37 CFR 1.34. Filing of such papers is considered to be a representation that the attorney or agent is authorized to act in a representative capacity on behalf of applicant. However, interviews with a registered attorney or agent not of record will ordinarily be conducted based only on the information and files supplied by the attorney or agent in view of 35 U.S.C. 122.”

MPEP Section 405. Because the undersigned attorney filed the subject Amendment Document, the undersigned is authorized to act on behalf of Applicant as to the Amendment Document. Additionally, because the undersigned supplied the Amendment Document at issue here, interviews with the undersigned attorney are proper. It is submitted that the present Amendment Document is the very type of situation contemplated by MPEP Section 405, namely to resolve issues raised by the Office based on the paper submitted by the practitioner. No justification exists for not returning phone calls or inquiries relating to the Amendment Document. Prosecution is delayed needlessly, and possibly to Applicant's prejudice, especially where the Amendment Document in fact complies with the Rules and the MPEP.

Non-Compliant Specification Amendments

Paragraph Markings

This is the **SECOND** Notice of Non-Compliant Amendment Document the Examiner has issued in this case. None of the amendments in the December 27, 2007 Amendment Document violate any requirement, mandate, rule or policy, including those established by the Patent Office Rules of Practice and the MPEP.

As to Specification amendments, the Office Action states that no markings are included in the amended paragraphs. The Office Action also states the “Replacement paragraphs or sections must be a marked-up version showing the changes. Applicant respectfully traverses the conclusion that the paragraphs are not marked.

According to the Rules, amendments are required to be indicated by underlining and/or strikethrough or double brackets (i.e. [[yyyyy]].) Specifically, the MPEP states that:

“37 CFR 1.121(b)(1)(ii) requires that the full text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text.”

See, MPEP Section 714 (II)(B), third paragraph. The only specification changes in the subject Amendment Document are **Additions**. There are no deletions. Consequently, the only indicators required in the Amendment Document are underlines. In fact, all of the text added to the identified paragraphs of the Specification as made by the Amendment is underlined in the Amendment Document. While a quick comparison of the text of the specification as filed with the applicable amendments easily shows what text is underlined, such a comparison is unnecessary because the underlining is clearly shown for each amendment. Simply by way of example, which is representative of all the amendments, the heading Range of Lipid is underlined and added by the amendment to the paragraphs at page 10, line 9, through page 11, line 9. (The reasons for the amendments are discussed explicitly in the Amendment Document.) Therefore, all requirements for amending the Specification are met in the Amendment Document.

The Examiner points to no added or new text that is not underlined, and in fact cannot do so. All of the marked text to be included in the paragraphs amended is underlined. No text is added that is not underlined. The Examiner gives no explanation for ignoring the underlined text. Clearly, the Amendment Document complies with the Rules.

The amendments in the Amendment Document are to Tables of Examples. The undersigned has found numerous examples of cases where tables and examples have headings that are not underlined. See for example, US RE40,259 and 7,363,619. Applicant is not aware of any requirement that table headings be underlined. Therefore, no apparent reason exists to state, as in the present Office Action, that no amendment markings can be located in the paragraphs of Examples.

Even if the added text was intended to be underlined in the final published text of the specification, which it was not, nothing in the Rules or the MPEP provides for “doubling underlining”, namely one underline for the text to be carried through to the final specification, and a second underline to indicate the addition of the first underline and the added text. Nothing has been found permitting double underlining. In any case, the added text is not intended to be underlined. Moreover, the very same text in the Application as filed and that was omitted from the published application was also not underlined. In any case, the Examiner is not making such an argument.

Applicant respectfully requests an indication of precisely what the Examiner finds fault with in the Specification Amendments. Clearly, the findings in the Office Action must be made in the context of the Amendment Document actually filed, as opposed to a hypothetical paper. At this point, there is insufficient information in the record to establish that the Amendment Document is non-compliant, and in fact all evidence is to the contrary.

Paragraph Numbers

The Examiner also states:

“Also, for applicants information, it is not proper to refer to paragraph numbers employed in an electronic version of a specification, when they do not appear in the copy of the specification as filed.

No support has been found for such a statement that paragraph number references are “improper”. According to the MPEP, what is required is an unambiguous identification of the paragraph to be modified:

“In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes.”

See, MPEP Section 714 (II)(B), first paragraph. While the second paragraph of the same section refers to applications where paragraph numbering was included with the application as filed, no prohibition has been found against using paragraph numbers (or anything approaching that they are “improper”). The Examiner cites nothing making paragraph numbers improper in the present case. They are in fact useful in the present case because the amendments are specifically because the application as published omitted the text in the originally-filed application. The reference to the paragraph numbers allows a reader to compare the published application paragraphs (using the paragraph numbers) with the application as filed to see the omitted text.

If this issue is relevant, and if the Examiner persists in stating that such references to paragraph numbers are improper, Applicant respectfully requests an appropriate citation to relevant authority in support thereof.

Non-Compliant Claim Status Identifiers

The Amendment Document included an Election of Species with Traverse. According to the MPEP, it is the Examiner who withdraws claims from consideration after an election of species with traverse. In the present application, the election was with traverse. The MPEP states specifically:

“All claims that the examiner **holds** as not being directed to the elected subject matter are withdrawn from further consideration by the examiner in accordance with 37 CFR 1.142(b).”

See MPEP Section 821 (emphasis added). Therefore, it is the Examiner that withdraws the claims, but only after reconsidering the traversed election requirement and only after holding that the claims are not directed to elected subject matter. There has been no

holding yet that any claims are directed to non-elected subject matter. Therefore, a "withdrawn" Status Identifier is inappropriate at this stage of the proceedings.

It is noted that, "for any amendment being filed in response to a restriction or election of species requirement and any subsequent amendment, any claims which are non-elected must have the status identifier (withdrawn)." See, MPEP Section 714 (II)(C)(A). However, that MPEP provision does not take into account an election with traverse, which event is specifically addressed in MPEP Section 821. Therefore, the more specific rule for election with traverse must prevail over the more general requirement of Status Identifiers. The Status Identifiers do not take into account a traverse.

In the present case, the Examiner states that "Claims 18, 34, 36-38, 42 and 43 have not been provided with the proper status identifier. The status of these claims should read: (Withdrawn)." In view of the foregoing, MPEP Section 821 states that these claims are withdrawn only after the Examiner holds that they are directed to non-elected claims after the traverse. Once such a holding is made, the Examiner indicates they are withdrawn from consideration.

Please charge any additional fees that may be due or credit any overpayments to our deposit Account No. 50-0655. If a petition is required in conjunction with this paper, please consider this a request for such a petition.

Respectfully submitted,

Dated: December 27, 2007

/James A Henricks/

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